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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,403	11/13/2006	Reiner Fischer	2400.0320000/VLC/CMB	1672
26111 7590 10/31/2008 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
BIANCHI, KRISTIN A				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
10/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,403

Applicant(s)

FISCHER ET AL.

Examiner

KRISTIN BIANCHI

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/05/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-19 are pending in the instant application and are subject to the following lack of unity requirement.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-5, 8 and 11-14, drawn to compounds, pesticides and/or herbicides and compositions of the formula (I).

Group II, claim 6, drawn to a process for preparing compounds of the formula (I).

Group III, claims 9 and 15, drawn to methods for controlling animal pests and/or unwanted vegetation which involve the use of compounds of the formula (I) (i.e. claim 9) or a composition according to Claim 12 (i.e. claim 15).

Group IV, claim 17, drawn to compounds of the formula (II).

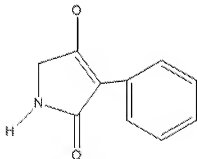
Group V, claim 18, drawn to compounds of the formula (XVI).

Group VI, claim 19, drawn to compounds 2-chloro-4-methyl-6-ethylphenylacetic acid, methyl 2-chloro-4-methyl-6-phenylacetate, 1'-(2-chloro-4-methyl-6-ethylphenyl)-2',2'-trichloroethane and 2-chloro-6-ethyl-4-methylaniline, which do not fall under any of the formulas (I), (II) or (XVI).

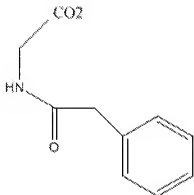
Claims 7, 10 and 16 drawn to subject matter that is non-statutory under 35 USC 101 and can not be examined as written (i.e. as use claims). The claims will be added to a new group or a preexisting group upon amendment to recite statutory subject matter as appropriate.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I, IV, V, VI consist of compounds (and pesticides and/or herbicides and compositions) of different formulas (i.e. (I), (II), (XVI), and the compounds of claim 19) which do not have a common core structure within the chemical structure of each compound. For example, the compounds of formula (I) contain



as the core structure whereas the compounds of formula



(II) contain

as the core structure.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore,

there is not a special technical feature present which links the claims as defined by PCT Rule 13.2.

Accordingly, Groups I-VI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Election of Species

Applicant is further required to elect a single disclosed species within the elected group and to provide the structure of the elected species. For example, if Group I is elected for prosecution, Applicant must disclose a single compound of formula (I). A single disclosed species is also required if any of Groups II-VI is elected for prosecution.

The species are as follows: the various structurally different compounds of formulas (I), (II), (XVI), and the compounds of claim 19 (i.e. a compound of formula (I) wherein G is (a) is structurally different than a compound of formula (I) wherein G is (b).

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner: the compounds of formula (I) correspond to claims 1-6, 8, 9, and 11-15, the

compounds of formula (II) correspond to claim 17, the compounds of formula (XVI) correspond to claim 18, and the compounds 2-chloro-4-methyl-6-ethylphenylacetic acid, methyl 2-chloro-4-methyl-6-phenylacetate, 1'-(2-chloro-4-methyl-6-ethylphenyl)-2',2',2'-trichloroethane and 2-chloro-6-ethyl-4-methylaniline correspond to claim 19.

The following claims are generic: 1-6, 8, 9, 11-15, and 17-19.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: for example, a compound of formula (I), (II) or (XVI) wherein A and B together with the carbon atom to which they are attached represent a saturated C3-C8-ring which contains one nitrogen atom is structurally different than a compound of formula (I), (II) or (XVI) wherein A and B together with the carbon atom to which they are attached represent a saturated C3-C8-ring which contains an oxygen atom, therefore, these compounds are different species or they lack the same core structure or special technical feature. Also, the compounds of claim 19 are all structurally different and, therefore, are different species or they lack the same core structure or special technical feature.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIN BIANCHI whose telephone number is (571)270-5232. The examiner can normally be reached on Mon-Fri 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626

Kristin Bianchi
Examiner
Art Unit 1626
